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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,092	02/21/2002	Barton A. Pasternak	35783-152950	2819
23973	7590	06/02/2004		
DRINKER BIDDLE & REATH ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			EXAMINER	
			NEGRON, ISMAEL	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/081,092	PASTERNAK ET AL.	
	Examiner Ismael Negron	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 March 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3 and 5-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 5-14 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1)  Notice of References Cited (PTO-892)
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4)  Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5)  Notice of Informal Patent Application (PTO-152)
- 6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response filed on March 5, 2004 has been entered. No claims have been amended, added or cancelled. Claims 1-3 and 5-14 are still pending in this application, with claims 1, 7, 8 and 13 being independent.

#### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the socket being adapted to be rotated at least 360° about two axes (claim 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification as filed discloses a socket adapter capable of 360° rotation about one axis, and less than 360° about a second axis. The structure disclosed by the instant application is capable of rotating about a longitudinal axis of the screw base 26, and about hinge 35. While rotation of at least 360° about the longitudinal axis of the screw base 26 is possible (and indeed claimed), hinge 35 is not capable (emphasis added) of such 360° rotation.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2 and 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of CHAN (U.S. Pat. 4,716,505).

WOHL discloses directionally adjustable socket adapter having:

- **a rotatable upper portion**, Figure 1, reference number 20;
- **the upper portion being for receiving a light bulb**, Figure 1;
- **a lower portion**, Figure 1, reference number 10;
- **the lower portion adapted to engage a socket**, column 1, lines 1-5;
- **a hinge**, Figure 1, reference number 16;

Art Unit: 2875

- **the upper portion being attached to the lower portion by the hinge, Figure 1, reference numbers 17 and 18;**
- **the directionally adjustable socket adapter being adjustable to a plurality of directional arrangements by the hinge, column 1, lines 51-55;**
- **the upper portion also being rotatable about a longitudinal axis of the lower portion, column 2, lines 5-13;**
- **the upper portion having a housing and an inner socket, inherent; and**
- **a light bulb, Figure 1, reference number 21.**

WOHL discloses all the limitations of the claims, except the upper portion being rotatably engage to the lower portion and having at least 360° of rotation about the longitudinal axis of the lower portion.

CHAN discloses an illumination device (Figure 1) having rotatable coupling (Figure 3) capable of at least 360° rotation (column 2, lines 46-62).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the rotatable coupling of CHAN in the illumination device of WAHL to provide such device with the capability of being in any desired direction, as per the teachings of CHAN.

Regarding the light bulb having a coating adapted to focus light emitted by the bulb in a desired direction, the Examiner take Official Notice that the use and advantages of such coated light bulbs is old and well known in the art. One of ordinary

Art Unit: 2875

skill in the art would have been motivated to use such light bulb in the device of WOHL to increase the efficiency of the illumination device by concentrating and directing the light rays towards an intended target of illumination.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of CHAN (U.S. Pat. 4,716,505) as applied to claims 1 and 2 above, and further in view of ANGOTT (U.S. Pat. 4,684,822).

The teachings of WOHL and CHAN disclose, or suggest in combination, all the limitations of the claims, except the housing having a plurality of sensors for receiving a remote signal, such signal controlling the brightness of the light bulb.

ANGOTT disclose a lamp dimmer system for remotely controlling lamps.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to include the lamp dimmer circuit of ANGOTT in the illumination device of WOHL and CHAN to be able to remotely control the operation of such illumination device, as per the teachings of ANGOTT (see column 1, lines 27-49).

#### ***Response to Arguments***

6. Applicant's arguments filed March 5, 2004 have been fully considered but they are not persuasive.

7. Regarding the Examiner's rejection of claim 14 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, and the objections to the drawings, the applicant argues that paragraph 0023 of the detailed description (as

filed) provides sufficient disclosure to enable of skilled in the art to make and used the invention as recited in claim 14. The examiner strongly disagrees.

As previously stated, the structure disclosed by the instant disclosure and drawings present a lighting device capable of 360° rotation about the axis of the screw base 26, however, 360° rotation about any other axis (e.g. hinge 35) is not possible since the screw socket 25 would prevent it. As evidenced by Figures 1-6, the claimed structure is only able to rotate about 180° about hinge 35.

8. Regarding the Examiner's rejection of claims 1-3 and 5-14 under 35 U.S.C. 10103(a) as being unpatentable over WOHL (U.S. Pat. 2,190,439) in view of CHAN (U.S. Pat. 4,716,505), the applicant argues that the proposed combination of references lack motivation since the patented structure of WOHL already includes the advantages of the claimed invention, specifically the capability of being oriented in any desired direction, or being able to focus light emitted by the bulb in a desired direction.

9. In response to applicant's argument that there is no motivation to include the commutator of CHAN in the structure of WOHL, since WOHL already provides the capability to be oriented in any direction, the applicant is advised to carefully review the disclosure of WOHL.

WOHL is only capable of being rotated about 180° about the screw socket as evidenced by Figure 5, where the slot 12 is shown to extend partially (emphasis added) around the tubular wall of the Edison-type socket. Such structure is limited in its capacity to project light from a light bulb in any direction, as would be possible with the addition of the commutator of CHEN. The increased versatility in orientation was

Art Unit: 2875

considered motivation enough to propel one of ordinary skill in the art at the time the invention was made in light of the disclosure of CHEN.

10. In response to applicant's argument that there is no motivation to include the old and well known light bulb coating to focus light emitted by the bulb in a desired direction, the applicant is advised that the structure patented by WOHL does not includes a reflector.

WOHL is silent as to the function or nature of the reflector-like structure shown in ghost image by Figure 1 and as such cannot be construed to be part of the disclosed adjustable light socket. However, if applicant's interpretation is taken as fact, such reflector-like structure provides evidence of the desirability of reflective members to redirect light from the light bulb 21 to a desired direction. Using one of the prior art light bulbs with integrated reflective coatings would have flown naturally to one of ordinary skill in the art at the time the invention was made, since such light bulbs would not only reduce the number of components and size of the structure of WOHL, but also simplify it.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ismael Negron whose telephone number is (571) 272-2376. The examiner can normally be reached on Monday-Friday from 9:00 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra L. O'Shea, can be reached on (571) 272-2378. The facsimile machine number for the Art Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications maybe obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://pair-direct.uspto.gov>. Should you have questions on access to Private PAIR system, contact the Electronic Business Center (EBC) toll-free at 866-217-9197.



THOMAS M. SEMBER  
PRIMARY EXAMINER

*[Handwritten initials]*  
Inr

May 27, 2004